

REMARKS

Summary of the Office Action

In the Office Action dated May 19, 2003, the previous rejection of claims 3-14 under 35 U.S.C. §102(b) set forth in the prior Office Action dated October 30, 2002, as being anticipated by U.S. Patent No. 5,236,572 to Lam et al. (hereinafter “Lam”), has been withdrawn because the reference does not teach or suggest forming a metallic thin layer on an inner or interior surface of a cylindrical substrate (drum) as instantly claimed in the process of producing an endless belt. Claims 3-14 and 21-32 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by newly cited U.S. Patent No. 5,411,779 to Nakajima et al. (hereinafter “Nakajima”). Claims 3-14 and 21-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lam in view of Nakajima.

Summary of the Response to the Office Action

Applicants traverse the rejection of the claims and respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims 3-14 and 21-32.

The Rejection under 35 U.S.C. § 102(b)

Claims 3-14 and 21-32 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Nakajima. Applicants respectfully traverse this rejection for the following reasons.

Applicants respectfully submit that Nakajima does not teach or suggest all of the features of independent claim 3. Independent claim 3 recites a process for producing an endless belt including, amongst other features, the step of “forming a metallic thin film on an inner surface of a cylindrical substrate.” For example, in the process for producing an endless belt having a metallic thin film of the instant invention, as recited in claim 3, a metallic thin film is formed on an inner surface of a cylindrical substrate.

In contrast, the tubular article of Nakajima, as recited at least at column 3, lines 13-15, comprises “a tubular inner layer made of polyimide resin and a tubular outer layer made of a fluoroplastic.” Nakajima refers to the fluoroplastic layer as an “electrically conductive fluoroplastic solution.” The Office Action asserts that the electrically conductive fluoroplastic solution includes conductive powders, such as metal powder.

Applicants respectfully submit that there is no teaching or suggestion in Nakajima of establishing a fluoroplastic solution as a substitute or equivalent for a metallic thin film on an inner surface of a cylindrical substrate. Moreover, Applicants respectfully submit that a person of ordinary skill in the art at the time that the invention was made would not construe the fluoroplastic solution of Nakajima to be analogous to the metallic thin film of the instant invention, since a fluoroplastic solution has no metal content. Accordingly, Applicants respectfully submit that the step of “forming a metallic thin film on an inner surface of a cylindrical substrate” in the process for producing an endless belt, as recited in claim 3, is distinct from the process of immersing “in an electrically conductive fluoroplastic solution” recited at least at column 10, lines 40-41 of Nakajima.

Absent any teaching or suggestion in Nakajima of “forming a metallic thin film on an inner surface of a cylindrical substrate,” Applicants respectfully assert that Nakajima does not teach or suggest every feature of independent claim 3. As pointed out in MPEP §2131, ‘[t]o anticipate a claim, the reference must teach every element of the claim.’ Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Accordingly, Applicants respectfully request that the rejection of claim 3 under 35 U.S.C. §102(b) be withdrawn.

Likewise, independent claim 21 recites a process for producing an endless belt comprising the step of “forming a metallic thin film on an inner surface of a drum.” Accordingly, Applicants respectfully traverse the rejection of independent claim 21 under 35 U.S.C. §102(b) for at least the same reasons as set forth above with regard to independent claim 3. Thus, Applicants respectfully request that the rejection of claim 21 under 35 U.S.C. §102(b) also be withdrawn.

Moreover, Applicants respectfully submit that dependent claims 4-14 and 22-32 are not anticipated by Nakajima for at least the same reasons as set forth above with regard to independent claims 3 and 21 upon which they respectively depend. Accordingly, Applicants respectfully request that the 35 U.S.C. §102(b) rejection of claims 4-14 and 22-32 be withdrawn.

The Rejection under 35 U.S.C. § 103(a)

Claims 3-14 and 21-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lam in view of Nakajima. Applicants respectfully traverse this rejection for the following reasons.

With regard to Lam, Applicants thank the Examiner for the withdrawal of the rejection of claims 3-14 under 35 U.S.C. §102(b) set forth in the prior Office Action dated October 30, 2002, as being anticipated by Lam. The Office Action states at page 2 that Lam “does not teach or suggest forming a metallic thin layer on an inner or interior surface of a cylindrical substrate (drum) as instantly claimed in the process of producing an endless belt.” Applicants respectfully submit that, in light of the arguments presented above with regard to claims 3 and 21, Nakajima fails to cure the deficiencies of Lam in that Nakajima also does not teach or suggest “forming a metallic thin film on an inner surface of a cylindrical substrate.”

Accordingly, Applicants respectfully assert that Nakajima and Lam, whether taken singly or in combination, do not teach or suggest each feature of independent claim 3 or independent claim 21. As pointed out in MPEP § 2143.03, “[to] establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” Thus, Applicants respectfully submit that claims 3 and 21 are in condition for allowance as not being anticipated by Lam in view of Nakajima. Accordingly, Applicants

respectfully request that the rejection of claims 3 and 21 under 35 U.S.C. 103(a) be withdrawn.

Furthermore, Applicants respectfully submit that dependent claims 4-14 and 22-32 should be allowed at least because of their respective dependence upon allowable claims 3 and 21. Accordingly, Applicants respectfully request that the rejection of dependent claims 4-14 and 21-32 under 35 U.S.C. 103(a) be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims 3-14 and 21-32.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

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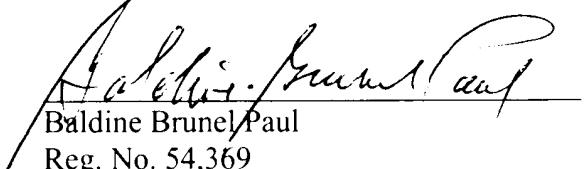
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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